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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/666,878

09/19/2003

Evan E. Koslow

KXIN 100027000

8886

22891

7590

06/17/2009

LAW OFFICE OF DELIO & PETERSON, LLC.

121 WHITNEY AVENUE

3RD FLOOR

NEW HAVEN, CT 06510

EXAMINER

FORTUNA, JOSE A

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

06/17/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/666,878

Applicant(s)

KOSLOW, EVAN E.

Examiner

José A. Fortuna

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 16-20, 24 and 42-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 16-20, 24, 42-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-12, 14, 16-20, 24 and 42-47 rejected under 35 USC § 103(a). This rejection is set forth in the prior Office action mailed on December 29, 2008.

Response to Arguments

3. Applicant's arguments filed on March 30, 2009 have been fully considered but they are not persuasive.

Applicant argues that the secondary reference(s) does/do not teach the precipitation of the interception agent on at least portion of at least some of the fibers as it is claimed, but the reference(s) teach/teaches a contact-killing, non-leaching coating on the surface of an article. Also, applicant argues that the precipitation of additives onto papermaking fibers is only known for the precipitation of calcium carbonate and the claimed precipitation would not have been obvious to one of ordinary skill in the art. Applicant also argues that the rejection was based on an improper hindsight. Applicant arguments have been considered unconvincing for the following reasons:

- As the onset of the discussion, it is important to note that the claims are drawn to products and products are evaluated by their properties, not by the way they are made. Since the combination of the references produces a paper that has all the additives and raw materials of the claimed paper, even if the additives are added in other fashion, which it is not necessarily true, see arguments below, then the product taught by the reference reads on the claimed paper, specially when it has not been shown that the properties of such products are different. Note also that the claims use the phrase the precipitant is formed on “at least portion of said...” which reads on the whole thing or a very minute portion of the fibers and therefore, the coating of the fibers with the precipitate is within the scope of the claims, as well as just producing, forming, a speckle of the precipitant on the fibers.
- Moreover, it is the examiner contention that the secondary references teach that the contact-killing agent could be precipitated onto the fibers, and coating is a preferred embodiment, or at the very least the reading of the secondary references suggest to one of ordinary skill in the art that such additive could be precipitated on the fibers, specially when the *in situ* precipitation of additives is known in the art, see discussion on the next bullet-section, below. Note that Sawan et al. teach that adding the interception agent can be done either by producing it, i.e., making it first, and then adding to the substrate or can be formed *in situ* in the substrate, see for example, column 4, lines 11-19 of the US’325 or column 4, lines 18-24; column 9, lines 16, of the US’468, where they specifically teach that the article is

first contacted with the carbonyl compound and then contacted with a metal salt solution as to deposit the metal on the surface of the article, reproduced for below, (EMPHASIS ADDED).

“In methods of the invention a surface and pores of a filter are coated with a metal. In one embodiment, a filter having pores is provided, *the filter is contacted with a carbonyl compound, the filter is dried, and the dried filter is contacted with a metal salt solution or metal carboxylate salt solution and an amine-containing compound solution so as to deposit the metal on the surface and within a plurality of the pores.* In one embodiment, this filter is then washed and dried. The filter can be any of the filters described above.”

It is clear from the teachings that deposition of the metal, refers to the precipitation of the metal in the surface of the article or within its pores. The latter is more clearly taught by the US'468 on column 9, lines, 34-41, reproduced below, which teaches that the carbonyl compound acts as a reducing agent, so that the metal ion is reduced to the metal, i.e., precipitates, (EMPHASIS ADDED):

“The carbonyl compound acts as a reducing agent, so that the metal ion is reduced to the metal, e.g., silver ion is reduced to metallic silver. This electroless redox reaction occurs in situ in solution or in the solid state. The carbonyl compound has affinity for aqueous and non-aqueous phases and therefore can be used in the process of coating either hydrophilic or hydrophobic filters.”

- With respect to the arguments that the precipitation of additives onto papermaking fibers is only known for loading the fibers with calcium carbonate, the examiner respectfully disagrees. While it is true that it is very common to precipitate calcium carbonate on the fibers of paper, for chemical and/or economical reasons, the precipitation of other additives are also known, see for example US Patent No. 6,406,594 attached here as an evidence.

- In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/José A Fortuna/
Primary Examiner
Art Unit 1791

JAF